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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,720	08/31/2001	Hans-Urich Petereit	211892USOPCT	2655

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EXAMINER

JOYNES, ROBERT M

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 08/26/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,720

Applicant(s)

PETEREIT ET AL.

Examiner

Robert M. Joynes

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>12</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Receipt is acknowledged of applicants' Amendment filed on June 11, 2003 and Information Disclosure Statement filed on April 11, 2003.

Information Disclosure Statement

The Information Disclosure Statement filed April 11, 2003 has been received but no PTO 1449 was found with the Statement. The Examiner has considered the information Disclosed but no PTO 1449 was provided to initial and sign. It is suggested a proper PTO 1449 be provided for Examiner to initial and sign.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmann et al. (US 5705189) in combination with Vetter et al. (US 5548033).
Lehmann teaches thermoplastic materials which are copolymers of acrylic and/or

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methacrylic acid, methacrylate and alkyl ester of acrylic and/or methacrylic acid (Col. 2, lines 52-65). These copolymers are molded into capsules or capsule halves (Col. 2, lines 62-65). These capsules are formed by injection molding a melt of the copolymers at temperatures of 120° to 180° C (Col. 2, line 66 – Col. 3, line 2; Col. 4, lines 3-6;

Example 1). Additional materials can be added to the thermoplastic material copolymer such as plasticizers, fillers, dyes, pigments, preservatives, flavoring substances, active substance, and mold-release agents (Col. 3, line 62 – Col. 4, line 13). The polymers of Lehmann can be formed by extrusion (Col. 3, lines 10-20).

Lehmann does not expressly teach that the copolymer melt is devolatilized by extrusion.

Vetter teaches a method of processing plastic melts wherein the plastic is a poly(methyl methacrylate) and the melt is subject to extrusion to devolatilize the melt (Col. 5, line 13 – Col. 6, line 6).

Neither reference expressly teaches that exact concentration ranges or temperature ranges for the individual ingredients recited in the instant claims.

While the reference does not teach the complete concentration or temperature range, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955).

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At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add the step of devolatilization to a process of preparing capsule from thermoplastic melts of copolymers of acrylic and/or methacrylic acid, methacrylate and alkyl ester of acrylic and/or methacrylic acid. Lehmann teaches a method of making capsule through injection molding with the same material as are claimed in the instant application. Lehmann teaches that the capsules are bubble free and fissure free. Vetter teaches a method of forming plastics in which the extrusion step of the process devolatilizes the polymer from impurities or unwanted monomeric units as well as water. Therefore, it would have been obvious at the time of the invention that extrusion can devolatilize the melted polymeric mixture and removes water from the mixture.

One of ordinary skill in the art would have been motivated to do this to remove the risk of the mixture being subject to non-homogeneous changes (Col. 5, lines 13-20).

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant's arguments filed June 11, 2003 have been fully considered but they are not persuasive. Applicants argue that the primary reference (Lehmann) does not teach a devolatilization step for producing an injection molded capsule and that the secondary reference is not relevant art.

It is the position of the Examiner that the primary reference teaches that the melted polymeric mixture can be extruded when being formed. The secondary

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reference teaches that the extrusion step can be used to remove water from the polymeric mixtures as well as unwanted monomeric units. This devolatilization provides for a more homogenous mixture of the polymers being used. Therefore, it is the position of the Examiner that the instant claims are rendered obvious over the prior art, as stated above herein.

Applicants also argue that the devolatilization step of Vetter is incorporated for a different purpose than the instant application being that water is positively added in the process of the prior art. First, the instant claims do not exclude the positive inclusion of water to the process. Second, the prior art does not have to recognize the same motivation or reasoning for providing a step in the process. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (discussed below); In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991) (discussed below). Although Ex parte Levengood, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) states that obviousness cannot be established by combining references "without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done" (emphasis added), reading the quotation in context it is clear that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention.

Therefore, the rejections recited in the October 22, 2002 Office Action are maintained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Joynes whose telephone number is (703) 308-8869. The examiner can normally be reached on Mon.-Thurs. 8:30 - 6:00, alternate Fri. 8:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone

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number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Robert M. Joynes
Patent Examiner
Art Unit 1615
August 21, 2003


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600